

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. The Office Action mailed December 13, 2006 rejected claims 1-2, 4-6, 8-10, 12-15 and 17-20 under 35 U.S.C. § 103 and rejected claims 3 and 11 under 35 U.S.C. § 103. In addition, claims 7 and 16 are rejected under 35 U.S.C. § 103. Claims 1, 9 and 15 have been amended. Claims 3 and 11 have been cancelled.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

Applicants wish to thank the Examiner for conducting a telephonic interview on Tuesday, February 6, 2007. During the interview, many of the amendments disclosed herein were discussed.

A. Claims 1-2, 4-6, 8-10, 12-15 and 17-20 Rejected Under 35 U.S.C. § 103(a)

The Office Action rejected claims 1-2, 4-6, 8-10, 12-15 and 17-20 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,987,105 to Jenkins et al. (hereinafter, "Jenkins") in view of U.S. Patent No. 6,023,698 to Lavey, Jr. et al. (hereinafter, "Lavey"), and further in view of U.S. Patent No. 6,246,677 to Nap et al. (hereinafter, "Nap"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The Office Action has not established a *prima facie* case of obviousness against these claims. Specifically, the Office Action fails to establish a *prima facie* case because the cited references fail to disclose, teach or suggest all the limitations of the claims and because Nap and Merriam teach away from the proposed combination.

Claim 1 recites that “the user identification is used for billing purposes.” Applicants respectfully submit that the proposed combination does not disclose, teach or suggest this limitation.

The Office Action admits, and Applicants agree, that “Jenkins differs from the claims in that the identification stored and accessed is the device serial number, not a user identification.” Office Action, page 3 (parenthetical citations omitted). Furthermore, the Office Action has not cited, nor can Applicants find, any portion of Jenkins that discloses, teaches or suggests that “the user identification is used for billing purposes,” as recited in claim 1. In fact, Applicants can find no mention of “billing” in Jenkins.

The Office Action asserts that “Lavey teaches that it is old and well known to use a product’s serial number as user identification.” *Id.* In support of this assertion, the Office Action cites the following portion of Lavey, “[w]hen a registration operation is performed, a registration token containing user identification information, such as a CD Key, a serial number from the CD-ROM packaging or another uniquely defined user identification, is used for registering the client application with the server site.” Lavey, col. 8, lines 17-20. Applicants respectfully submit that nothing in this cited portion discloses, teaches or suggests that “the user identification is used for billing purposes,” as recited in claim 1. Furthermore, Applicants respectfully submit that a serial number identifies a device or product. A device or product is not “bill[ed],” as recited in claim 1, rather a user is. As with Jenkins, Applicants cannot find any mention of “billing” in Lavey.

Furthermore, Lavey does not concern “billing,” as recited in claim 1. Rather, Lavey is concerned with “Registering and Updating Information over the Internet.” Lavey, Title. There would be no motivation to use Lavey’s registration token “for billing purposes,” as recited in claim

I, because when the user attempts to register and/or update their information over the Internet, the user will have already purchased the CD-ROM.

The Office Action admits, and Applicants agree, that “[t]he combination of Jenkins and Lavey ... does not specify using the serial number for billing purposes.” Office Action, page 3. However, the Office Action asserts that “as shown by Nap, it is old and well known to use the serial number of a remotely monitored device for billing purposes (col. 15, lines 58-65) such that it would have been obvious to incorporate such use of the device’s serial number for billing, as taught by Nap, within the combination of Jenkins and Lavey.” *Id.* at pages 3-4. The Office Action stated, as an apparent motivation to combine the cited references, that this combination would be desirable “in order to provide the subscriber with accurate billing details regarding services performed for the home appliance.” *Id.* at page 4. However, the proposed combination of Nap with Jenkins and Lavey is improper, and therefore does not disclose, teach or suggest this claim limitation, because Nap teaches away from Jenkins.

The M.P.E.P. states that “[a] prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. M.P.E.P. § 2144.05 citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). In fact, if there is such “teaching away” in a reference, then this “finding alone” defeats any assertion of obviousness under § 103(a). See *Winner Int’l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). This is because “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The Federal Circuit has held that a reference teaches away from a claimed invention when the reference leads its reader “in a direction divergent from the path that was taken by the applicant.” *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

Nap discloses an “Automatic Meter Reading Data Communication System.” Nap, Title. The purpose of this “Automatic Meter Reading Data Communication System” is just that, to be automatic. For example, Nap discloses that user involvement is undesirable. See Nap, col. 1, lines 31-32 (“visual on-site meter reading by utility service personnel is highly labor intensive, inefficient

and very expensive.”) Furthermore, Nap characterizes the present invention as “automatic.” See Nap, col. col. 2, lines 54-57 (“The present invention is an automatic meter reading data communication system”). A straight-forward reading of Nap makes it clear that the purpose of the invention is to communicate the meter reading data “automatically.”

It is well settled that if the proposed modification/combination would render one of the references unsatisfactory or inoperable for its intended purpose, then these references teach away from their combination and make an obviousness rejection improper. M.P.E.P. § 2143.01; In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (holding that where the proposed combination/modification would cause the device outlined by the reference to become inoperable for its intended purpose, then this modification is improper and cannot be made). The Office Action’s proposed combination would render Nap unsatisfactory or inoperable for its intended purpose.

The intended purpose of Nap is to communicate the meter reading data “automatically.” If Nap were combined with Jenkins and Lavey, the purpose of Nap would be destroyed because a user would be required to hold the phone to the utility meter. A user holding a telephone to a utility meter is not “automatic,” as required by Nap. Therefore, Nap clearly teaches away from any user interaction such as the “generate audio command [that is] initiated by a user,” as recited in claim 1. Therefore, in addition to being divergent from the teachings of Nap, “initiat[ing] [a generate audio command] by a user,” as recited in claim 1, would also render Nap unsatisfactory for its intended purpose. Consequently, Nap teaches away from the Office Action’s proposed combination. Thus, Nap cannot be combined with Jenkins, Lavey or any reference that does not perform automatically. Therefore, because Nap teaches away from these claim elements, Nap cannot be combined with Jenkins and Lavey to render claim 1 unpatentable.

Because Nap teaches away from Jenkins and Lavey and because the Office Action admits that Jenkins and Lavey fail to disclose that “the user identification is used for billing purposes,” as recited in claim 1, none of the cited references disclose, teach or suggest this claim element. Because the cited references do not disclose, teach or suggest this claim element, the Office Action has not presented a *prima facie* case of obviousness against claim 1.

Furthermore, claim 1 recites “provid[ing] the audio output data to the speaker.” Claim 1 has also been amended to recite that “the audio output comprises DTMF tones.” Support for this amendment may at least be found in Applicants’ Specification, on page 2, lines 28-29; page 7, lines 6-14; and page 14, line 21. Applicants respectfully submit that none of the cited references disclose, teach or suggest “provid[ing] the audio output data [comprising DTMF tones] to the speaker,” as recited in claim 1.

The Office Action admits, and Applicants agree, that “[t]he combination of Jenkins, Lavey and Nap ... does not specify the signal tones as being DTMF tones.” Office Action, page 5. However, the Office Action asserts that “Merriam teaches the well known use of DTMF tones (Abstract) to transmit status information such that it would have been obvious to an artisan of ordinary skill to incorporate such use of DTMF tones, as taught by Merriam, within the combination of Jenkins, Lavey and Nap for outputting the audible signals.” Id.

However, Merriam does not teach “provid[ing] the audio output data [comprising DTMF tones] to the speaker,” as recited in claim 1. The Office Action asserts that “Merriam teaches the well known use of DTMF tones (Abstract) to transmit status information.” Office Action, page 5. However, Merriam’s Abstract does not disclose, teach or suggest that the DTMF tones are “provide[d] ... to the speaker,” as recited in claim 1. Rather, Merriam discloses that the DTMF tones are “transmitted via the telephone line.” Merriam, Abstract.

Transmitting via a telephone line is not the same as “provid[ing] the audio output data [comprising DTMF tones] to the speaker,” as recited in claim 1. Furthermore, the Office Action has not cited, nor can Applicants find, any portion of Merriam that discloses, teaches or suggests “provid[ing] the audio output data [comprising DTMF tones] to the speaker.” Rather, Merriam discloses the use of “terminals for connection to a telephone line ... and a DTMF tone generator coupled to the terminals ... for producing a set of tone pairs representing the data for transmission over the line.” “[P]roducing a set of tone pairs” is not the same as “provid[ing] the audio output data [comprising DTMF tones] to the speaker, as recited in claim 1. Rather, the “tone pairs” are merely

“transmit[ted] over the [telephone] line.” Therefore, Merriam does not disclose, teach or suggest this claim limitation.

Furthermore, Applicants respectfully submit that the Office Action has not provided a motivation to combine Jenkins, Lavey and Nap with Merriam. Rather, the Office Action merely states that “it would have been obvious to incorporate such use of DTMF tones ... for outputting the audible signals.” *Id.* Applicants respectfully submit that this is not a proper motivation to combine Merriam with these references because Merriam does not disclose, teach or suggest “outputting audible signals.”

Additionally, if the Office Action’s motivation to combine these references is “for outputting the audible signals,” Applicants respectfully submit that this motivation would render Merriam unsatisfactory or inoperable for its intended purpose. *See* M.P.E.P. § 2143.01 above.

A straight-forward reading of Merriam makes it clear that the purpose of the invention is to “provide an inexpensive meter reading and data transmitting apparatus for a telephonic **automatic** meter reading system.” Merriam, col. 2, lines 46-48 (emphasis added). If Merriam were combined with Jenkins and Lavey, the purpose of Merriam would be destroyed because a user would be required to hold the phone to the utility meter. A user holding a telephone to a utility meter is not “automatic,” as required by Merriam.

Furthermore, Merriam teaches away from “provid[ing] the audio output data [comprising DTMF tones] to the speaker, as recited in claim 1. For example, Merriam states that the “[i]ntegrity of the collected [utility meter] information is of paramount importance.” Merriam, col. 3, lines 53-55. Merriam further states that “[b]y providing suitable flexibility in the equipment, other functions such as tamper detection and remote disconnect can be provided.” Merriam, col. 3, lines 61-63. These statements in combination with the stated purpose of Merriam to “provide an inexpensive meter reading and data transmitting apparatus for a telephonic automatic meter reading system,” clearly teach away from any user interaction in meter readings.

Because Merriam teaches away from any user interaction, Merriam, like Nap, cannot be combined with Jenkins, Lavey or any reference that does not perform automatically. Therefore,

because Merriam teaches away from these claim elements, Merriam cannot be combined with Jenkins and Lavey to render claim 1 unpatentable.

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn. Claims 9 and 15 include similar limitations as claim 1. Applicants respectfully request that the rejection of claims 9 and 15 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 2, 4-6 and 8 depend either directly or indirectly from claim 1. Claims 10 and 12-14 depend either directly or indirectly from claim 9. Accordingly, Applicants respectfully request that the rejection of claims 2, 4-6, 8, 10 and 12-14 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 9.

The previous two and the present Office Action assert that “[r]egarding claims 19-20, a cellular telephone can be used at the appliance site in the same manner as handset 9 to transmit the audible data signal generated by loudspeaker 5.” See Office Action of March 8, 2006, page 5; Office Action of August 31, 2006, page 4; and Office Action of December 13, 2006, page 4. Claim 19 recites “wherein the communication network is a cellular telephone network.” Claim 20 recites “wherein the communication network is a radio network.” Applicants respectfully submit that neither the present nor the previous two Office Actions have provided any explanation or support for the rejection claim 20. Rather, the present Office Action has improperly grouped the distinct subject matter of cancelled claims 19 and 20.

Furthermore, Applicants previously responded to these assertions by stating the following:

Applicants respectfully submit that Jenkins does not disclose “a cellular telephone network,” as recited in claim 19, or “a radio network,” as recited in claim 20. In fact, Jenkins does not disclose anything about a cellular telephone, as asserted. Rather, Jenkins only discloses a Public Switched Telephone Network. See Jenkins, Figure 1, col. 4, lines 23-25, and col. 10, lines 23-27. Applicants respectfully submit that a Public Switched Telephone Network is not the same as “a cellular telephone network,” as recited in claim 19, or “a radio network,” as recited in claim 20.

The assertion that a cellular telephone may be used in the same manner as handset 9 is not disclosed by Jenkins. Therefore, Jenkins does not disclose either "a cellular telephone network," as recited in claim 19, or "a radio network," as recited in claim 20. Consequently, because Jenkins does not disclose either "a cellular telephone network," as recited in claim 19, or "a radio network," as recited in claim 20, Jenkins does not anticipate claims 19 and 20.

June 12, 2006 Office Action Response, page 9. The present Office Action has not responded to these arguments, other than again merely asserting that "Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection." Office Action, page 6. However, the present Office Action provided no new grounds of rejection for claims 19 and 20. Rather, the present Office Action merely repeats the same prior assertions. Applicants respectfully submit that their prior arguments remain valid and that Jenkins does not disclose, teach or suggest "a cellular telephone network," as recited in claim 19, or "a radio network," as recited in claim 20.

Furthermore, the present Office Action has not cited, nor can Applicants find, any portion of Lavey that discloses, teaches or suggests the aforementioned claim limitations. Rather, Lavey merely discloses a "System and Method for Transparently Registering and Updating Information over the Internet." Lavey, Title. Applicants respectfully submit that the Internet is not the same as "a cellular telephone network," as recited in claim 19, or "a radio network," as recited in claim 20.

Likewise, the Office Action has not cited, nor can Applicants find, any portion of Merriam or Nap that discloses, teaches or suggests the aforementioned claim limitations. Therefore, Merriam and Nap do not disclose, teach or suggest all of the limitations of claims 19 and 20. Furthermore, as shown above, Nap and Merriam teaches away from the proposed combination with Jenkins and Lavey.

In view of the foregoing, Applicants respectfully submit that claims 19 and 20 are patentably distinct from the cited references. Additionally, claims 17-20 depend directly from claim 15. Accordingly, Applicants respectfully request that the rejection of claims 17-20 be withdrawn for at least the same reasons as those presented above in connection with claim 15.

B. Claims 3 and 11 Rejected Under 35 U.S.C. § 103(a)

The Office Action rejected claims 3 and 11 under 35 U.S.C. § 103(a) based on Jenkins, Lavey and Nap, and further in view of U.S. Patent No. 5,311,581 to Merriam et al. (hereinafter, "Merriam"). Claims 3 and 11 have been cancelled. Therefore, Applicants respectfully request that the rejection of claims 3 and 11 be withdrawn.

C. Claims 7 and 16 Rejected Under 35 U.S.C. § 103(a)

The Office Action rejected claims 7 and 16 under 35 U.S.C. § 103(a) based Jenkins in view of Lavey, and further in view of U.S. Patent No. 5,729,596 to Reeder et al. (hereinafter, "Reeder"). This rejection is respectfully traversed.

The standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is provided above. Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The Office Action has not established a *prima facie* case of obviousness against these claims.

The Office Action has not provided a motivation to combine Reeder with Jenkins, Lavey and Nap. As shown above, the Office Action must provide "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142.

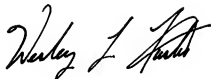
However, the Office Action merely asserts that "Reeder teaches that it is well known to communicate data from a television as well as a washing machine or microwave oven (identify code from TV 1b as well from WM 1d or μ W 1e) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of a home appliance such as a television, as taught by Reeder, within combination of Jenkins, Lavey and Nap." Office Action, page 5. Because the Office Action has failed to provide a motivation to combine Reeder with Jenkins, Lavey and Nap, the Office Action has not presented a *prima facie* case of obviousness against claims 7 and 16.

In view of the foregoing, Applicants respectfully submit that claims 7 and 16 are patentably distinct from the cited references. Furthermore, claim 7 depends directly from claim 1. Claim 16 depends directly from claim 15. Accordingly, Applicants respectfully request that the rejection of claims 7 and 16 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 15 because the prior art references do not teach or suggest all the claim limitations.

D. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', with a stylized flourish at the end.

/Wesley L. Austin/

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